IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Jeffrey C. Hawkins et al.

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EXAMINER: Sam Bhattacharya

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In connection with the Notice of Appeal submitted herewith, please consider the included

remarks below as part of a Panel Review of the present application.

REMARKS

Pre-appeal brief review is appropriate in this application because the rejections of claims 1-11, 20, 29, 30, and 33-47 in the April 6, 2006 Final Office Action contain clear deficiencies.

I.   Rejections Under 35 USC 102(b) in View of Nguyen

Claims 33, 34, 36, 44, 45, and 47 were rejected as being anticipated by U.S. Patent Application No. 5,797,089 ("Nguyen"). This rejection is respectfully traversed.

The independent claim 33 generally recites a method for operating a personal electronic device using two distinct user actions – opening a lid of the device and activating a power button. When the device is off, responsive to the lid being opened, the device becomes activated and a first application is executed in the device. When the device is off, responsive to activation of the power button, the device becomes activated and a second application is executed in the device. In this manner, a user can choose to achieve the effect of activating the device and executing the first application by lifting the lid, or to achieve the effect of activating the device and executing the second application by activating the power button. Claim 44 recites a similar method.

Nguyen fails to teach such limitations. Nguyen merely discloses a personal communications terminal (the PCT) that includes a personal digital assistant unit (the PDA unit) and a mobile telephone unit (the Phone unit) hingedly connected together. *See* Nguyen, Abstract. The PCT can be extended into an open position by pivoting the PDA unit and the Phone unit around a mechanical hinge connecting them. *See* Nguyen, col. 3, ll. 46-51. There is no hint or suggestion anywhere in Nguyen of any technique for activating a device and executing applications responsive to two distinctive user actions. Specifically, there is no discussion in Nguyen of activating a device and executing an application responding to a lid being opened.

The Examiner's citations to specific portions of Nguyen do not relate in any way to the above-referenced limitation of the claims. Specifically, the Examiner cited column 6, line 58 to column 7, line 3 of Nguyen as allegedly anticipating the limitation of activating the device and executing an application responding to the lid being opened. However, the cited section of Nguyen merely discusses determining the power status of the PDA unit and the Phone unit and enabling the functions associated with those units that are powered on. The above cited section of Nguyen is not related to the claimed limitation because *determining* the power status of a device is different from *activating* the device, the former merely checking the power status of the device while the latter changing the power status of the device from off to on. Furthermore, the above cited section of Nguyen is not related to the claimed limitation because *enabling* a function is different from *executing* an application. Enabling a function means that the function is rendered capable or able to be executed by the device, while executing an application means that the device runs the application by carrying out the instructions of the application.

The Examiner disagreed with the above distinction between enabling and executing in an Advisory Action dated August 28, 2006. Specifically, the Examiner stated that "Step 71 [of Figure 4] enables PDA functions, thus executing applications in response to the lid being opened." Nguyen, in fact, distinguishes enabling and executing of a function. In Figure 4 of Nguyen, step 71 is labeled "Enable PDA Functions" and step 72 is labeled "PDA Execute Phone/Fax Function?" In the corresponding section of Nguyen, the reference discusses about enabling the functions associated with the units that are powered on and determining "whether the user has requested the PDA unit 31 to execute a phone or a FAX function …." Therefore, in Nguyen, enabling a function only renders the function ready to be executed. As a result, Nguyen does not disclose the claimed limitation of activating the device and executing an application

responding to the lid being opened.

Thus, for at least the above reasons, Nguyen clearly fails to disclose each and every limitation of the claimed invention. Likewise, claim 44 is patentably distinguishable over Nguyen for the same reasons.

As to dependent claims 34, 36, and 45, because claims 34 and 36 are dependent on claim 33, and claim 45 is dependent on claim 44, all arguments advanced above with respect to claims 33 and 44 are applicable to claims 34, 36, and 45.

As to dependent claim 47, because claim 47 is dependent on claim 4, which recites method steps similar to those of claim 33, all arguments advanced above with respect to claim 33 are applicable to claim 47.

II.   Rejections Under 35 USC 103(b) in View of Nguyen and Boesen

Claims 1, 2, 7-11, 20, 29, 30, 35, 37-43, and 46 were rejected as being obvious in view of Nguyen and U.S. Patent Application Publication 2001/0027121 A1 ("Boesen"). This rejection is respectfully traversed.

A.   Claims 1, 2, 7-11, 29, 30, 35, 37-43, and 46

The independent claim 1, similar to claim 33 discussed above, generally recites a method for operating a personal digital assistant. The method activates the device and executes a first application in the device responsive to the lid of the device being opened. The method also activates the device and executes a second application in the device responsive to another distinctive event. Independent claims 7, 9, 29, and 30 recites methods, systems, and computer program products having similar limitations as claim 1. As discussed above, there is no hint or

suggestion anywhere in Nguyen of activating a device and executing an application responding to a lid being opened.

Boesen, like Nguyen, clearly fails to disclose all the limitations of the claimed invention or supply that which Nguyen lacks. Boesen discloses a personal electronic device with two bodies that can be attached together. *See* Boesen, Abstract. Boesen discloses that users of the device can open the two bodies of the device. *See* Boesen, Paragraphs 49 and 50; Figures 6 and 7. However, Boesen does not hint or suggest the opening of the two bodies of the device activates the device or executes an application in the device. Thus, Boesen, like Nguyen, clearly fails to disclose all the limitations of the claimed invention or supply that which Nguyen lacks.

Thus, Nguyen and Boesen, whether taken singly or in combination, clearly fail to disclose each and every limitation of the claimed invention. Likewise, claims 7, 9, 29, and 30 are patentably distinguishable over Nguyen and Boesen for the same reasons.

As to dependent claims 2, 8, 10, 11, and 37-43, because claims 2 and 37-43 are dependent on claim 1, claim 8 is dependent on claim 7, and claims 10 and 11 are dependent on claim 9, all arguments advanced above with respect to claim 1 are applicable to claims 2, 8, 10, 11, and 37-43.

As to dependent claims 35 and 46, because claim 35 is dependent on claim 33, which recites method steps similar to those of claim 1, and claim 46 is dependent on claim 4, which also recites method steps similar to those of claim 1, all arguments advanced above with respect to claim 1 are applicable to claims 35 and 46.

B.   Claim 20

The independent claim 20, similar to claim 33 discussed above, generally recites a method for operating a personal digital assistant (the PDA). The method turns on the PDA and launches a phone application responsive to a lid of the PDA having been opened. As discussed above, neither Nguyen nor Boesen hints or suggests about turning on a device responding to a lid being opened or launching an application responding to the lid being opened. Thus, Nguyen and Boesen, whether taken singly or in combination, clearly fail to disclose each and every limitation of the claimed invention.

III.   Rejections Under 35 USC 103(b) in View of Nguyen, Boesen, and Takahashi

Claims 3-6 were rejected as being obvious in view of Nguyen, Boesen, and U.S. Patent No. 6,662,244 ("Takahashi"). This rejection is respectfully traversed.

The independent claim 4, similar to claim 33 discussed above, generally recites a method for operating a personal digital assistant. The method activates the device and executes a first application in the device responsive to the lid of the device being opened. The method also activates the device and executes a second application in the device responsive to activation of a jog rocker. As discussed above, neither Nguyen nor Boesen hints or suggests about activating a device responding to a lid being opened or executing an application responding to the lid being opened.

Takahashi, like Nguyen and Boesen, clearly fails to disclose all the limitations of the claimed invention or supply that which both Nguyen and Boesen lack. Takahashi discloses an information terminal made up of a first housing and a second housing. *See* Takahashi, Abstract. The first housing and the second housing are connected at hinged ends so that the second

housing can be rotated around the hinge end relative to the first housing. *See* Takahashi, col. 3, ll. 43-48. However, Takahashi does not hint or suggest any technique for activating the device and executes a first application in the device responsive to the lid of the device being opened. Specifically, Takahashi does not disclose anything related to the terminal executing applications. Thus, Nguyen, Boesen, and Takashi, whether taken singly or in combination, clearly fail to disclose each and every limitation of the claimed invention.

As to dependent claims 5 and 6, because claims 5 and 6 are dependent on claim 4, all arguments advanced above with respect to claim 4 are applicable to claims 5 and 6.

As to dependent claim 3, because claim 3 is dependent on claim 1, which recites method steps similar to those of claim 4, all arguments advanced above with respect to claim 4 are applicable to claim 3.

III.   **Summary**

Based on the foregoing, Applicants respectfully submit that each of the pending rejections suffers from a clear deficiency in the prima facie case asserted in support of the rejection. The Commissioner is respectfully requested to contact the undersigned should it be beneficial for advancing prosecution of the present application.

Respectfully Submitted,
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